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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/052,936	10/25/2001	Meng Ngee Philip Tan	1050/207	1122

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EXAMINER

GRAYSAY, TAMARA L

ART UNIT

PAPER NUMBER

3623

DATE MAILED: 12/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/052,936

Applicant(s)

TAN, MENG NGEE PHILIP

Examiner

Tamara L. Graysay

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 October 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input checked="" type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Priority

1. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 119 as follows:

An application in which the benefits of an earlier application are desired must contain a specific reference to the prior application(s) in the first sentence(s) of the specification or in an application data sheet by identifying the prior application by application number (37 CFR 1.78(a)(2) and (a)(5)). If the prior application is a non-provisional application, the specific reference must also include the relationship (i.e., continuation, divisional, or continuation-in-part) between the applications except when the reference is to a prior application of a CPA assigned the same application number.

2. It is noted that this application appears to claim subject matter disclosed in prior Application No. 60/243064, filed 25 October 2000. A reference to the prior application must be inserted as the first sentence(s) of the specification of this application or in an application data sheet (37 CFR 1.76), if applicant intends to rely on the filing date of the prior application under 35 U.S.C. 119(e), 120, 121, or 365(c). See 37 CFR 1.78(a). For benefit claims under 35 U.S.C. 120, 121, or 365(c), the reference must include the relationship (i.e., continuation, divisional, or continuation-in-part) of all nonprovisional applications. If the application is a utility or plant application filed under 35 U.S.C. 111(a) on or after November 29, 2000, the specific reference to the prior application must be submitted during the pendency of the application and within the later of four months from the actual filing date of the application or sixteen months from the filing date of the prior application. If the application is a utility or plant application which entered the national stage from an international application filed on or after November 29, 2000, after compliance with 35 U.S.C. 371, the specific reference must be submitted during the pendency of the application and within the later of four months from the date on which the

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national stage commenced under 35 U.S.C. 371(b) or (f) or sixteen months from the filing date of the prior application. See 37 CFR 1.78(a)(2)(ii) and (a)(5)(ii). This time period is not extendable and a failure to submit the reference required by 35 U.S.C. 119(e) and/or 120, where applicable, within this time period is considered a waiver of any benefit of such prior application(s) under 35 U.S.C. 119(e), 120, 121 and 365(c). A benefit claim filed after the required time period may be accepted if it is accompanied by a grantable petition to accept an unintentionally delayed benefit claim under 35 U.S.C. 119(e), 120, 121 and 365(c). The petition must be accompanied by (1) the reference required by 35 U.S.C. 120 or 119(e) and 37 CFR 1.78(a)(2) or (a)(5) to the prior application (unless previously submitted), (2) a surcharge under 37 CFR 1.17(t), and (3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2) or (a)(5) and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional. The petition should be addressed to: Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450.

If the reference to the prior application was previously submitted within the time period set forth in 37 CFR 1.78(a), but not in the first sentence(s) of the specification or an application data sheet (ADS) as required by 37 CFR 1.78(a) (e.g., if the reference was submitted in an oath or declaration or the application transmittal letter), and the information concerning the benefit claim was recognized by the Office as shown by its inclusion on the first filing receipt, the petition under 37 CFR 1.78(a) and the surcharge under 37 CFR 1.17(t) are not required. Applicant is still required to submit the reference in compliance with 37 CFR 1.78(a) by filing an amendment to the first sentence(s) of the specification or an ADS. See MPEP § 201.11.

Information Disclosure Statement

3. The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609.04(a) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

Drawings

4. The drawings are objected to because of the following:
- a. They fail to comply with MPEP § 608.01, VI, which reads in part, "The description portion of the specification may contain tables *>, but the same tables must not be included in both the drawings as a figure and in the description portion of the specification." (see for example pages 14, 17, 18, 20, 22, 25, etc. of the specification).
 - b. They fail to comply with 37 CFR 1.84(p)(4) because reference character "1" has been used to designate several elements including elements in Figures 1-7. Similarly, other reference characters are improperly used to designate more than one element. This is an example. Applicant must ensure that all of the reference characters refer to only one element as depicted in the drawings. The reference characters used for the process steps in figures 2-4 should be distinguished from each other using for example Step 2-1, 2-2, 2-3, etc. instead of 1, 2, 3, and so on, i.e., the same reference character should not be used for different process steps.

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- c. They fail to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: for example, 1-9, 15, 20, 25, 30, 35, 40, 50, 60, 70, 80, 90, 100 (Figure 6); 25, 35, a, b, c, d, and 1-9 (Figure 7); 200, 210, 220, 230, 240 (Figure 8). These are just examples, all of the drawings must be reviewed by applicant to ensure that the reference characters depicted therein are mentioned in the specification.
- d. They fail to comply with 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the analysis, correlation, and prediction steps conducted via at least one communication link, as recited in claim 7; and, the communication link is a computer link between enterprises and professional advisers, as recited in claim 8, must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

5. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

6. The disclosure is objected to because of the following informalities:

a. The same reference characters are used for different elements throughout the specification and figures. For example, reference character 1 is used

- at page 14, the upper left box of the diagram,
- at page 17, in the diagram,
- at page 18, in the figure,
- at page 19, lines numbered 4, , 9, 14,
- etc.

b. Page 12, line 2, reference is made to Figure 3.3; however, there is no Figure 3.3 in the application.

c. Pages 14, 17, 18, 20, 22 fail to comply with MPEP § 608.01, VI, which reads in part, "The description portion of the specification may contain tables *>, but the same tables must not be included in both the drawings as a figure and in the description portion of the specification."

d. Page 15, line numbered 27, reference characters 2 and 5 refer to passive and friendly, respectively; however, the reference characters are not the same as those depicted in Figure 1 for passive and friendly.

Appropriate correction is required.

Claim Objections

7. Claims 1-8 are objected to because of the following informalities:

There are several grammatical errors that should be corrected. For example:

Claim 1, line 10, predicting various subsequent combination of alliance outcomes should be either predicting a subsequent combination of alliance outcomes or predicting various subsequent combinations of alliance outcomes.

Claim 1, line 12, whereby managerial and alliance resources may targeted should be whereby managerial and alliance resources may be targeted.

Claim 7, line 2, “analysis, correlation and prediction” should be steps of analyzing, correlating, and predicting.

Claim 8, line 2, [like] should be link.

Appropriate correction is required.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

8. Claims 1-8 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

In order to be statutory, the claims must recite a practical application, i.e., produce a useful, concrete, and tangible result. A result that is useful, concrete, and tangible is one that has a real world value and is reproducible. Arguably a multi-dimensional simulation method may be useful in the field of joint ventures and business alliances, generally. However, the claims do not recite a concrete and tangible result. Although the claims include simulation by mapping in a two-dimensional model having points representative of an alliance strategy and performance, the added correlating step does not produce a result but instead simulates a win/win situation, without claiming what the win/win situation represents in relation to the strategy and performance aspects of the alliance. Further the step of predicting subsequent combination alliance outcomes is not a result but rather an abstract idea, i.e., not concrete and tangible, without a result. Using points to represent characteristics or features of a simulation is abstract in nature, i.e., not a concrete and tangible result.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

9. Claims 1-8 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

- a. Claim 1, the step of predicting various subsequent combination of alliance outcomes with reference to the optimal win/win situation is not described in a way to enable one of ordinary skill in the computer modeling art to make and/or use the invention. There is not adequate discussion to enable one skilled in the art to know how to identify an optimal win/win situation because the specification does not describe what characteristics comprise a win/win situation that is optimal.
- b. Claim 1, the conditional clause whereby managerial and alliance resources may be targeted at the appropriate stages while ensuring the durability and stability of the alliance is not described in a way to enable one of ordinary skill in the computer modeling art to make and/or use the invention. There is not adequate discussion to enable one skilled in the art to know what is meant by “target[ed],” what the managerial resources are, how they are targeted, what the alliance resources are, how they are targeted because the specification does not describe targeting, or targeting while ensuring durability and stability of the alliance.

- c. Claim 1, the conditional clause whereby targeting is accomplished while ensuring the durability and stability of the alliance is not described in a way to enable one of ordinary skill in the computer modeling art to make and/or use the invention. There is not adequate discussion to enable one skilled in the art to recognize durability and stability, and ensuring durability and stability of the alliance. Undue experimentation would be required for one skilled in the art to determine what features are representative of durability and stability.
- d. Claim 6, the correlation of the strategy, structure, and performance to the degree of separability of an alliance asset is not described in a way to enable one of ordinary skill in the computer modeling art to make and/or use the invention. There is not adequate discussion to enable one skilled in the art to know what is meant by an alliance asset and the degree of separability therefrom. Also, one skilled in the art would not know how the degree of separability is to be correlated to strategy, structure and performance of the alliance. As a result, undue experimentation is required in order for one skilled in the art to determine how the degree of separability and the strategy, structure and performance are correlated and what is the correlation.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10. Claims 1-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1, line 11, “the optimal win/win situation” lacks antecedent basis in the claim. The claim is not clear whether this element is the same as the win/win situation recited at line 6.

Claim 1, line 13, “the durability and stability of said alliance” lacks antecedent basis in the claim. The claim is not clear whether this element is the same as the alliance fitness recited at line 3.

Claim 2, is not clear whether the analyzing step is being further modified or whether an additional correlating step is being performed prior to the analyzing step. Clarification is required.

Claim 3, is not clear whether the analyzing step is being further modified or whether an additional correlating step is being performed prior to the analyzing step. Further, the outcomes recited in claim 3 should be related to or clearly distinguished from the alliance outcomes recited at line 10 of claim 1. Clarification is required.

Claim 6, the degree of separability lacks antecedent basis in the claim.

Claim 7, line 2, the claim has been interpreted as though the step of conducting has been claimed.

Claim 8, line 2, “said communication link” lacks antecedent basis.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 1-4, 7 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Murray (article, Nonlinearity as a tool for business process reengineering) in view of Bond (article, Systems analysis and business process mapping: a symbiosis).

a. Regarding claim 1 and 4, Murray discloses a business process reengineering approach of multi-dimensional analysis. The “state space” (p.4, ¶5 – p.5, ¶2) is multiple dimension system that provides a practical way of examining system behavior. Where each state is descriptive so that simple rules of intervention may be applied to manage the system (p.4, ¶9) through each state. Although the reference is used to analyze patient progress (for example, p.4, ¶7, 11 – p.5, ¶2), it is equally applicable to other areas. In fact, the process was taken from the business field and applied to the medical field, demonstrating its universal nature (p.5, ¶8). Further, Murray teaches that the process includes unique states reflecting the various combinations of possible conditions – possible states of the system. Although the particular states are not presented, the teaching remains that there are possible states and various combinations that are contemplated and taught by Murray.

Bond teaches mapping of strategy (p.2, ¶7, entity relationship) and performance (p.2, ¶7, data flow). The process includes correlating the structure of the alliance (p.2, ¶3, process chain mapping methodology information system).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Murray to include alliance strategy and performance correlated to the structure of the alliance, such as suggested by Bond, in order to reflect the possible states and various combinations of the alliance.

b. Regarding claims 2 and 3, the particular type of outcome is a label, i.e., nonfunctional descriptive material. As such, it is of no weight in the process claim insofar as the nonfunctional descriptive material does not change or modify the process in a manipulative sense.

c. Regarding claims 7 and 8, the process is performed using a computer that, due to the transfer of data, inherently comprises a communication link, as broadly recited. The entity to which the computer is linked is a matter of design choice insofar as computers are capable of being linked between an enterprise and professional advisers. Arguably, the communication link in Murray is between an enterprise and professional advisers (between the employer and the healthcare professional).

Conclusion

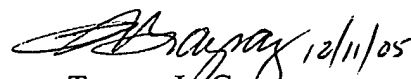
12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Baraldi (article, The quantitative journey in a qualitative landscape: developing a data collection model and a quantitative methodology in business network studies) teaches mapping business relationships (BRs) s they relate to products, production facilities, and business units. Figures 5 and 6 present connectedness maps having differing complexities.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tamara L. Graysay whose telephone number is (571) 272-6728. The examiner can normally be reached on Mon - Fri from 8:30am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz, can be reached on (571) 272-6729. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Tamara L. Graysay
Examiner
Art Unit 3623